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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,855	01/21/2004	Carl A. Forest	013194.0101D1US	5924
24283	7590	07/19/2004	EXAMINER	
PATTON BOGGS 1660 LINCOLN ST SUITE 2050 DENVER, CO 80264			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/762,855	<b>Applicant(s)</b> FOREST, CARL A.	
	<b>Examiner</b> Scott E. Jones	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01212004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 31-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In independent claims 31, 55, and 58, Applicant claims an “expert that is not said person”. Human beings are not patentable subject matter (See 1077 OG 24).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 31-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 31, 55, and 58, the language “expert that is not said person” renders the claims non-enabled since human beings are not patentable subject matter (See 1077 OG 24).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 31-34, 40-42, 46-51, 53-56, and 58-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (U.S. 5,507,485).

Fisher discloses a golf computer and method for suggesting shot and/or club selections to a golfer based on discrete physical factors (the golfer's position, weather and climate conditions, the layout of the hole, the golfer's stroke capabilities as learned from previous shots made by that golfer with particular clubs and under various conditions, the golfer's history on the particular hole, etc.) that is completely interactive with the actual golfer on an individual basis. The golf computer serves as a personal advisor while the golfer is playing a round of golf, can replay a round of golf after a player has completed a round of golf, and can serve as a golf coach by directing the golfer to practice certain shots with particular clubs, and even under certain conditions and on certain holes. These features discussed above are accomplished automatically, minimizing or eliminating the need for human intervention into the golf "caddie" function.

Fisher further discloses:

Regarding Claims 31, 34, 40, 41, 42, 50, 51, 53, 54, 55, 56, 58, and 61:

- an electronic storage device for storing a plurality of discrete physical factors (the golfer's position, weather and climate conditions, the layout of the hole, the golfer's stroke capabilities as learned from previous shots made by that golfer with particular clubs and under various conditions, the golfer's history on the particular hole, etc.) describing a real or hypothetical situation in golf and for storing golf action information regarding a plurality of different kinds of discrete actions (shot and club selection) that may be taken in response to the situation

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(Abstract, Figures 2, 3, 4a-c, 5, 7, 12-23, Column 1, lines 5-19, Column 3, line 65-Column 4, line 3, Column 4, lines 20-29, Column 4, lines 42-Column 5, line 8, Column 6, lines 1-Column 7, line 14, Column 7, lines 38-41, Column 7, lines 59-64, Column 8, lines 13-25, Column 9, lines 7-23, Column 9, line 44-Column 10, line 44, Column 11, lines 5-15, Column 11, line 65-Column 12, line 26, Column 12, lines 47-62);

- a processor communicating with the electronic storage device for selecting a plurality of specific discrete actions from said action information, and specific discrete actions being automatically selected by said processor responsive to said plurality physical factors (Abstract, Figures 2, 3, 4a-c, 5, 7, 12-23, Column 1, lines 5-19, Column 3, line 65-Column 4, line 3, Column 4, lines 20-29, Column 4, lines 42-Column 5, line 8, Column 6, lines 1-Column 7, line 14, Column 7, lines 38-41, Column 7, lines 59-64, Column 8, lines 13-25, Column 9, lines 7-23, Column 9, line 44-Column 10, line 44, Column 11, lines 5-15, Column 11, line 65-Column 12, line 26, Column 12, lines 47-62);
- an output device having a display for communicating said plurality of specific discrete actions to the golfer (Figure 3).

Regarding Claims 32 and 60:

- at least one of the plurality of different kinds of discrete actions is a golf shot (Column 4, lines 20-29).

Regarding Claims 33 and 59:

- the sport is golf (Column 1, lines 6-19).

Regarding Claim 46:

- the electronic storage device, said processor, and said output device are part of a personal computer (Figure 2).

Regarding Claim 47:

- the electronic storage device, said processor, and said output device are part of a portable computer small enough to be held in a human hand (Figure 3).

Regarding Claims 48 and 49:

- the electronic storage device, said processor, and said output device are part of a cellular telephone or wireless Internet communication (Column 6, lines 1-14, and Column 7, lines 1-14).

Furthermore, regarding claims 31, 55, and 58, Fisher discloses each of the structural limitations or elements as claimed. The limitation, “for storing a plurality of discrete physical factors describing a real or hypothetical situation in said athletic sport for storing athletic sport action information regarding a plurality of different kinds of discrete actions that an expert that is not said person would take in response to said situation:” is a functional limitation or intended use limitation that can inherently be performed by Fisher. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (U.S. 5,507,485) in view of Wilens (U.S. 5,779,566).

Fisher discloses that as discussed above regarding claims 31-34, 40-42, 46-51, 53-56, and 58-61. Fisher seems to lack explicitly stating:

Regarding Claim 35:

- the sport is tennis.

Regarding Claim 36:

- the sport is hockey.

Regarding Claim 37:

- the sport is skiing.

Regarding Claim 38:

- the electronic storage device stores a plurality of groups of said discrete actions, each group representing a response of a different expert to one or more predetermined situations.

Regarding Claim 39:

- an input device for selecting one of said experts.
- Wilens, like Fisher, teaches of a handheld computerized golf data recording, reporting, and advising unit, and a method for its operation. Wilens additionally teaches:

Regarding Claims 35, 36, and 37:

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- Wilens' invention is not limited to golf, but can be used in any sport or game for which it is desirable to record and report a large amount of data (Column 16, lines 48-53).

Regarding Claims 38 and 39:

- Wilens teaches of a number of randomly-accessed, game-interactive advice/feedback modes. By using the "choices" key (18) on unit (10) these three advice/feedback modes can be randomly accessed from certain of the game-interactive screens involving golf problems and solutions to slicing, hooking, topping a ball, etc. (Column 8, lines 37-46, and Column 13, lines 1-27).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the game-interactive advice/feedback modes of Wilens in Fisher. Doing so would enable a golfer to get expert advice on a particular area of golf, such as, driving, putting, slicing, or hooking.

9. Claims 43-45, 52, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (U.S. 5,507,485) in view of Baker (U.S. 5,486,001).

Fisher discloses that as discussed above regarding claims 31-34, 40-42, 46-51, 53-56, and 58-61. Fisher seems to lack explicitly stating:

Regarding Claim 43:

- said visual information depicts an expert illustrating said one or more specific actions.

Regarding Claim 44:



- the visual storage portion stores a plurality of groups of said visual information, each group representing the response of a different expert to one or more predetermined situations.

Regarding Claim 45:

- an input device for selecting one of said experts.

Regarding Claim 52:

- the electronic storage device also stores expert comments regarding discrete actions, said processor further compares said selected plurality of specific discrete actions to said input plurality of specific discrete actions, and provides one or more expert comments when one of said selected actions does not agree with a corresponding input action.

Regarding Claim 57:

- comparing the selected discrete actions to the personal discrete actions and providing an expert comment related to a difference between corresponding ones of said selected and personal discrete actions.

Baker teaches of an expertly analyzed instructional aid (such as for a golf swing) employing visual or audio-visual techniques which allows for a flow of information in both directions between selected coaches (professional golfers) and pupils so as to help that pupil to improve a golf swing. Baker teaches:

Regarding Claim 43:

- said visual information depicts an expert illustrating said one or more specific actions (Column 9, line 57-Column 10, line 20).

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Regarding Claim 44:

- the visual storage portion stores a plurality of groups of said visual information, each group representing the response of a different expert to one or more predetermined situations (Column 9, line 57-Column 10, line 20, and Column 10, lines 40-58).

Regarding Claim 45:

- an input device for selecting one of said experts (Column 6, line 31-Column 8, line 47).

Regarding Claim 52:

- the electronic storage device also stores expert comments regarding discrete actions, said processor further compares said selected plurality of specific discrete actions to said input plurality of specific discrete actions, and provides one or more expert comments when one of said selected actions does not agree with a corresponding input action (Column 9, line 57-Column 10, line 20, and Column 10, lines 40-58).

Regarding Claim 57:

- comparing the selected discrete actions to the personal discrete actions and providing an expert comment related to a difference between corresponding ones of said selected and personal discrete actions (Column 9, line 57-Column 10, line 20, and Column 10, lines 40-58).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to employ the visual or audio-visual techniques of Baker in Fisher. Doing

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so enables a golf player to improve on personal movements and techniques relating to golf more quickly by actually viewing an expert perform the technique and without as much guesswork as may be required with expert golf advice provided in text.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones  
Examiner  
Art Unit 3713



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